

REMARKS/ARGUMENTS

Amendments in General

1. Claims 1, 15, and 18 have been amended to clarify that the menu of the present invention is based on the customer making fewer choices, but those choices causing the kitchen to change a number of parameters in preparing the food selections. These amendments add no new matter to the specification and acceptance of these amendments is respectfully requested.
2. Claims 1 and 18 have been modified to address the problem of these claims including an intended use.
3. Claims 3, 7, and 17 have been cancelled.
4. None of these amendments add any new matter to the specification and acceptance of these amendments is respectfully requested.

Claim Rejections - 35 USC § 112

5. The Examiner rejected claim 18 for inclusion of the word “hardcopy” as new matter. This has been corrected.

Claim Rejections - 35 USC § 102

6. The Examiner rejected claims 1-4, 6, 7, and 18 §102(b) as being anticipated by Brown.
7. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
8. Claims 3 and 7 have been cancelled. Regarding Claim 1, it has been amended to clarify that the menu of the present invention is based on the customer making fewer choices, but those choices causing the kitchen to change a number of parameters in preparing the food selections

9. This is fundamentally different from the Brown reference. The Brown reference is directed to a system and method for coordinating various electronically stored restaurant menus together with a pre-selected profile whereby the system selects choices from the various restaurant menus based upon the pre-entered profile and presents these items to the customer at the time of ordering. Brown is an electronic version of a cookbook which lists information about any particular food item. The advantage of Brown over a cookbook is that Brown provides the capability of searching the database quickly, and filtering out items which do meet the search criteria.

10. In Brown a customer may select each ingredient of each dish, or each meal. The significant thing is that in Brown a customer MUST select each ingredient of each dish, or each meal, in order to arrive at a meal that is compliant with his chosen diet plan.

11. The revised claim 1 states that a customer makes only two selections in order to control a variety of factors, such as ingredients, condiments, dressing, and preparation style. The simplicity of this two step selection option is not presented by Brown. Although the concept of the invention is simple, this simplicity is of great value. This is in contrast to the technology of Brown, which does not allow a customer to make a simple selection, and which requires data to be input into the system from the customer.

12. The present invention does not require the prior placement of a customer specific ordering profile nor does it require special ordering in order to ensure that food is prepared according to a specific standard or in compliance with particular standards. Upon selection of a particular dish, the customer by virtue of the indicators on the menu knows that a particular menu item will be made in compliance with a particular standard, including changes in ingredients, condiments, side dishes, and preparation method. Thus a customer may select “hamburger” and “heart friendly” and his order would be prepared using buffalo meat instead of ground beef, for a lower fat content. The bun might be sourdough instead of white bread, for the lower glycemic index of the sourdough bread, the mayonnaise used might be low fat, and the fries might be baked sweet potato fries instead of deep fat fried French fries. Brown does not offer this simple control of ingredients, condiments and side dishes. Brown would rate each menu selection, and the customer could choose to select or not select a particular dish offered.

Claim Rejections - 35 USC § 103

13. The Examiner rejected claims 15-17 under §103(a) as being unpatentable (obvious) in view of Brown when combined with Tsai and Mueller.

14. Applicable rules of analysis:

PTO guidance for examiner treatment of the *KSR* case has been issued by Deputy Commissioner Margaret A. Focarino on May 3, 2007 (*attached*).

Reasons for Combining Prior Art must Still be Provided: Commissioner Focarino states that "it remains necessary to identify the reason" why prior art should be combined. More completely, the conclusion of the Memorandum provides the following statement:

"[I]n formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

"Explicit" Reason to Combine Prior Art: Commissioner Focarino quotes with approval the statement in *KSR* that various teachings are explored "in order to determine whether there was an *apparent reason* to combine the known [prior art] elements in the fashion claimed by the patent at issue. To facilitate review, the analysis *should be made explicit*." (emphasis added by the PTO.)

[R]ejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

In re Lee (277 F.3d 1338; 61 U.S.P.Q.2D (BNA) 1430). That case goes on to remind us that:

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citations omitted]

15. The Examiner fails to explain explicitly why the cited references should be combined. "In *KSR*, the Court stressed the importance of the written record in obviousness analyses, noting that "[t]o facilitate review, [the] analysis should be made explicit." (*KSR Intl. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)). Furthermore, the Court made clear the impropriety of summary conclusions of obviousness ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some

rational underpinning to support the legal conclusion of obviousness.” (quoting *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

16. Applicants respectfully assert that the written record for the subject application is not complete and accurate because each of the Examiner’s rejections under §103 reflect the “mere conclusory statements” against which the Supreme Court warned in *KSR*. In each of the rejections under §103, the Examiner has done nothing more than list various “teachings” of elements of the claims from the cited references followed by single-sentence summary conclusion of obviousness.

17. For example, on Page 4, regarding claims 15, the Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art to have used a single button or touch area, as taught by Mueller, to allow a customer to choose a menu, such as a heart-healthy or a low carbohydrate menu, and then to represent each single item on each menu, such as hamburgers, with another single button, for the purpose of simplifying the operation of Brown’s menu for customers using Brown’s menu system. This summary conclusion is devoid of any reasoned statement or rationale to support the conclusion of obviousness beyond a passing reference to a general statement of the functionality of the cited patents.

18. The Brown reference is a fairly complex system linked to a database, and does not offer a two step selection option of the present invention. It specifically requires a many step process in order for a customer to receive a food item made compliant with his diet requirements. The Brown reference does not present a single menu, or a menu selection with multiple indicators for diet compliance at the time of ordering, nor the option of selecting only the food selection and the diet compliance preference, and having those two selections transfer into control of ingredients, condiments, dressings, and preparation methods. For instance, a customer using the menu system of the current invention may select “hamburger” and “heart friendly” and his order would be prepared using buffalo meat instead of ground beef, for a lower fat content. The bun might be sourdough instead of white bread, for the lower glycemic index of the sourdough bread, the mayonnaise used might be low fat, and the fries might be baked sweet potato fries instead of deep fat fried French fries. Brown does not offer this simple control of ingredients, condiments and side dishes. Brown would rate each menu selection, and the customer could choose to select or not select a particular dish offered. Another person might order “hamburger” and “low carb” and might get no bun, more vegetables, and fried vegetable sticks instead of potatoes.

19. The Tsai patent is directed to a cooking implement, and there is no rationale to link this particular piece of kitchen tool to a menu or restaurant system. There is no suggestion in Tsai suggesting such a combination with a menu or restaurant system.

20 Teaching, Suggestion, and Motivation is Maintained as a test by KSR, but TSM is not to be used as a "rigid application": The PTO acknowledges that the "teaching, suggestion, or motivation" test "could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a)" but that the "rigid application" of the TSM test had been repudiated.

21. [A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does. *KSR International Co. v. Teleflex Inc. et al.* (550 U. S. ___, April 30, 2007).

22. The combination of references which has been made by the Examiner has no support within the references themselves that teach doing what the Applicant claims. The Brown reference teaches the use of a computerized system to prescreen restaurants and menu items according to a profile submitted by the customer. The Tsai reference teaches a table-top grill for cooking foods. There is no suggestion or motivation within these references to make the combination which has been put forth by the Examiner nor is there any suggestion or motivation from the prior art. Although KSR clarifies that the test for teaching, suggestion, and motivation cannot be used as the sole and rigid test, it is still a useful test. No teaching, suggestion or motivation is found to combine these two patents.

23. However, the simplicity of an invention is not grounds in and of itself to support an obviousness rejection, nor can "Monday morning quarterbacking" utilizing the invention as a guide support a rejection based upon obviousness.

24. "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious." "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." [citations omitted] *In re Fritch*, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

25. While the claimed concept is admittedly simple when viewed in hindsight, it is this hindsight position that cannot be utilized as the frame of reference from whence the determination of obviousness is to be made.

26. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

27. Neither of the references which have been cited by the Examiner make any suggestion for modifying or combining the references or making the modifications that the Applicant has claimed as the invention. The Applicant respectfully submits that the present invention is not obvious over the prior art and requests that the Examiner's rejection be withdrawn.

Conclusion

28. For the reasons discussed above, the Applicant request reconsideration of the 35 USC § 102 and 35 USC § 103 rejections, and allowance of the revised claims.

29. If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

30. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 3rd day of March, 2008

Yours truly,

/Robert L. Shaver/

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Examiner Jeffrey A. Shapiro
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CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 CFR 1.8

I HEREBY CERTIFY that this correspondence is being transmitted to the United States Patent and Trademark Office by EFS-Web on the date below.

DATED: This 3rd day of March, 2008.

/Julie L. O'Tyson/
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